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PATENT
Customer No. 22,852
Attorney Docket No. 9007.0002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
David Seidler)	Group Art Unit: 3727
)	
Application No.: 09/933,992)	Examiner: Robin A. Hylton
)	
Filed: August 21, 2001)	Confirmation No.: 7709
)	
For: VIRTUAL HINGE)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO OFFICE ACTION

In reply to the Office Action mailed August 10, 2005, Applicant respectfully requests reconsideration of the above-referenced application in light of the following remarks.

In the Office Action, claims 40 and 41 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action asserts that claims 40 and 41 have a purported “inconsistency” because claim 40 recites that “at least one of the first and second plates has means for precluding sliding movement,” and because claim 41 allegedly recites that “both plates have means for precluding sliding movement.” Office Action at 2. Without providing any further explanation of the claim rejection, the Examiner suggests amending claim 40 to delete “at least one of.”

Applicant respectfully disagrees with the claim rejection under 35 U.S.C. § 112, second paragraph, and submits that the rejection should be withdrawn for at least the following reasons. Contrary to the assertions in the Office Action, the language of claims 40 and 41 is entirely consistent. For example, claim 40 is broad enough to encompass “means ...” incorporated with either the first plate, the second plate, or both of the first and second plates, and claim 41, which depends from claim 40, covers “means ...” associated with both of the first and second plates. Even though claim 40 is broader than claim 41, such breadth provides no basis for the rejection under 35 U.S.C. § 112, second paragraph. Indeed, M.P.E.P. § 2173.04 cautions that:

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

(Emphasis supplied).

Neither the breadth of claim 40 nor anything else justifies rejecting the claims under 35 U.S.C. § 112, second paragraph, as set forth in the Office Action.

Consequently, Applicant respectfully requests that the Section 112, second paragraph, rejection be withdrawn.

In the Office Action, claim 43 was rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,196,232 to Chkadua ("Chkadua"). The Office Action indicates that Chkadua fails to disclose magnets that are "rectangular," as recited in claim 43, but the Examiner alleges that utilizing magnets of rectangular shape "would have involved a mere change in shape of a component" and that "[a] change in shape is generally recognized as being within the level of skill in the art." Office Action at 2-3.

Applicant respectfully submits that the Section 103(a) rejection should be withdrawn because the Office Action does not establish any *prima facie* case of obviousness. As stated in M.P.E.P. § 2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied reference must teach or suggest each and every element recited in the claim. M.P.E.P. § 2143. Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference in a manner resulting in the claimed invention. *Id.* Third, a reasonable expectation of success must exist. *Id.* Moreover, the teaching or suggestion and the reasonable expectation of success must "be found in the prior art, and not [be based on] applicant's disclosure." M.P.E.P. § 2143 (citing *In re Vaeck*, 947 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

In this case, *prima facie* obviousness has not been established because (1) neither Chkadua nor any other source, teaches or suggests all of the features

recited in claim 43; and (2) even hypothetically if the cited reference could be modified as proposed by the Examiner, the Office Action does not provide a proper motivation to modify the reference in a manner resulting in Applicant's claimed invention. For example, the Office Action does not set forth any legally sufficient motivation or suggestion, and it does not cite any support for the allegations relating to changing the shape of magnets.

Applicant calls attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in original)(citations omitted). The Office Action does not establish why, other than to attempt to meet the terms of Applicant's claim, a skilled artisan would have modified Chkadua to have “first and second magnets [that] are rectangular,” as recited in claim 43.

The conjectural conclusions set forth in the Office Action do not suffice to establish a *prima facie* conclusion of obviousness. Moreover, Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the references.

For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claim 43, and the Section 103(a) rejection should be withdrawn.

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Applicant notes that the Office Action contains a number of assertions concerning the claims of the present application and the cited reference. Applicant declines to subscribe to any assertion in the Office Action regardless of whether it might be addressed specifically herein.

If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 9, 2005

By: _____


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